



UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

(11)

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

EXAMINER

ART UNIT	PAPER NUMBER
----------	--------------

DATE MAILED:

10

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/018,194

Applicant(s)

GILCHREST ET AL.

Examiner

Sandra Wegert

Art Unit

1647

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 November 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-52 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims 1-52 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other

Election/Restriction

Restriction to one of the following inventions is required under 35 U.S.C. 121.

- I. Claims 1-5, drawn to a method of preventing epidermal melanocyte cell loss, classified in class 424, subclass 130.1+.
- II. Claims 6-10, drawn to a method of inducing hair growth, classified in class 424, subclass 130.1+.
- III. Claim 11-15, drawn to a method for inducing hair color, classified in class 424, subclass 130.1+.
- IV. Claim 16-19 and 37-40, drawn to a method of maintaining hair color, classified in class 424, subclass 130.1+.
- V. Claims 20-24, drawn to a method of inducing skin color, classified in class 424, subclass 130.1+.
- VI. Claims 25-28 and 41-44, drawn to a method of maintaining skin color, classified in class 424, subclass 130.1+.
- VII. Claims 29-32, drawn to a method of inhibiting vertebrate epidermal cell loss, classified in class 424, subclass 130.1+.
- VIII. Claims 33-36 and 45-52, drawn to a method of maintaining hair growth in keratinocytes, classified in class 424, subclass 130.1+.

The inventions are distinct, each from the other because of the following reasons:

Although there are no provisions under the section for "Relationship of Inventions" in the M.P.E.P. § 806.05 for Inventive Groups that are directed to different products, restriction is deemed to be proper because these products constitute patentably distinct inventions for the following reasons: The methods of Inventions I – VIII are independent and distinct, each from each other, because the methods are practiced with materially different process steps for materially different purposes and each method requires a non-coextensive search because of different starting materials, process steps, goals and measured endpoints.

Furthermore, secondary restrictions are required under 35 USC 121:

- 1)
 - A. The Inventions named above as they pertain to Nerve Growth Factor/Nerve Growth Factor fragment.
 - B. The Inventions named above as they pertain to Sequence ID No: 4
 - C. The Inventions named above as they pertain to Sequence ID No: 9
 - D. The Inventions named above as they pertain to Sequence ID No: 10
- 2)
 - A. Invention VII using melanocytes.
 - B. Invention VII using keratinocytes.

Each item (A-D, Group 1) named above is independent and distinct, one from the other, because they have independent and distinct chemical structures. Their searches are non-overlapping, resulting in an undue search burden.

Art Unit: 1647

Each item (A-B, Group 2) named above is independent and distinct, one from the other, because they are independent and distinct cell types. Furthermore, 2A is unrelated to 2B. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together, or they have different modes of operation, or they have different functions, or they have different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the two cell types are generally not used together experimentally, have different biological functions, and produce different substances. Their searches are non-overlapping, resulting in an undue search burden.

In order to be fully responsive, Applicant must pick one of Inventions I-VIII, and one of Groups A-D. If Applicant elects to prosecute Invention VII, an additional cell type must also be chosen (Group 2).

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, separate search requirements, and different classification, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 C.F.R. 1.143)

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 C.F.R. 1.48(b) and by the fee required under 37 C.F.R. 1.17(i).

Art Unit: 1647

Advisory information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sandra Wegert whose telephone number is (703) 308-9346. The examiner can normally be reached Monday - Friday from 9:00 AM to 5:00 PM (Eastern Time). If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, Gary Kunz, can be reached at (703) 308-4623.

Official papers filed by fax should be directed to (703) 308-4242. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

SLW

May 30, 2001

Elizabeth C. Hummer